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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/596,211	07/15/96	SILVESTRINI	251692002120

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QM31/0106

EXAMINER	
WILLSE, D	
ART UNIT	PAPER NUMBER
3738	14

DATE MAILED: 01/06/99

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Office Action Summary

Application No.
08/596,221

Applicant(s)
SILVESTRI

Examiner
Dave Willse

Group Art Unit
3738



☒ Responsive to communication(s) filed on Sep 8, 1998

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 23, 24, 28, and 30-39 is/are pending in the application.

Of the above, claim(s) 38 and 39 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 23, 24, 28, and 30-37 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Newly submitted claims 38 and 39 are directed to an invention that is independent or distinct from the invention originally claimed, because the product as claimed can be used in a materially different process, as demonstrated by the Simpson et al. patent, for example, cited below.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 38 and 39 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claims 28 and 30-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 28, lines 3-4 lack syntax. In claim 31, line 2, "the circumference" lacks a proper antecedent basis. Other errors were noted.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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Claims 35-37 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Simpson et al., US 5,076,684, which discloses an implant 40 (column 1, lines 13-17) comprising multiple sections 46, 48, 50, 52, 54 having substantially different cross-sections (Figure 4; column 2, lines 39-53; column 5, lines 52-56; column 6, line 14; etc.). Because of the materials typically used for artificial corneas and intralamellar implants, the modulus of elasticity being less than 500 psi is inherent.

Claims 23, 24, 28, and 30-37 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Silvestrini et al., US 5,300,118. Attention is directed to Figures 11A and 11B and to column 10, lines 14-27.

The Applicant's remarks have been reviewed. In Silvestrini et al. '118, the stepwisely varying cross-sectional area of the implant in Figure 11B is less along the sections of the aligned notches because the cross-sectional area of the intervening space is not included. Moreover, each of the rings 111 and 112 can certainly be viewed individually as an implant or an insert so that the stepwise changing of the cross-sectional area is clearly met; nothing in the claims suggests that the implant or insert has to work alone in effecting correction of a refractive disorder.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after


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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

This application contains claims drawn to a non-elected invention. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144; MPEP § 821.01).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse, whose telephone number is (703) 308-2903. The supervisory patent examiner is Mickey Yu, whose telephone number is (703) 308-2672. The receptionist's phone number is (703) 308-0858, and the main FAX numbers are (703) 305-3591, 3590.

dhw: D. Willse
January 4, 1999


DAVE WILLSE
PRIMARY EXAMINER
ART UNIT 3738